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FEB 10 2004

Technology Center 2100

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In re Application of: KUNIJUKI KAJITA
Application No.: 10/018,658
Filed: December 21, 2001
For: **ENCODING/DECODING DEVICE AND
ENCODING/DECODING METHOD**

)
) **DECISION ON PETITION FOR**
) **ACCELERATED EXAMINATION**
) **UNDER M.P.E.P. §708.02(VIII)**
)

This is a decision on the petition, filed January 20, 2004 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII), which requests the Accelerated Examination of the above-identified application.

The petition is **DISMISSED**.

M.P.E.P. §708.02, Section VIII, which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d), states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (C) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;
- (D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (E) Submits a detailed discussion of the references, which **discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how** the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner (emphasis added).

Petitioner's submission is deficient in that it does not comply with item (E) above:

Petitioner's submission does not provide a detailed discussion of the references, which points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject

matter is patentable over the references. To be able to particularly point out how the claimed invention is patentable over the references as required by item (E) above, at least, a submission should include: (1) with respect to anticipation under 35 USC 102, a comparison between each claim and each of the references (limitation by limitation); and (2) with respect to obviousness under 35 USC 103, a showing of how and why one of ordinary skilled in the art would not have been able to combine the references to come up with the claimed invention.

In the instant petition, Petitioner's submission generally includes three following parts:

-Part 1: a discussion of all the references;

-Part 2: a discussion of the claimed subject matter (claims 17-33) without (1) a comparison between the claimed invention and each of the references, and (2) a showing of how and why one of ordinary skilled in the art would not have been able to combine the references; and

-Part 3: a general conclusion to the effect that "[t]he references cited above, either alone or in combination, fail to disclose or suggest at least the above-noted features of the present claims including any of, *inter alia*, ..."

Petitioner's general conclusion with respect to the patentability of the claimed subject matter over the references without (1) a comparison between each claim and each of the references (limitation by limitation), and (2) a showing of how and why one of ordinary skilled in the art would not have been able to combine the references to come up with the claimed invention does not comply with item (E) above.

Accordingly, the Petition is **DISMISSED**. The application file will be forwarded to the Central Files of Technology Center 2100 to await examination in its proper turn based on its effective filing date. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision.



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